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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/693,881	10/28/2003	Takashi Kubo	244640US0	4046
22850	7590	11/04/2005	EXAMINER	
OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			RONESI, VICKEY M	
			ART UNIT	PAPER NUMBER
			1714	
DATE MAILED: 11/04/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Advisory Action Before the Filing of an Appeal Brief	Application No.	Applicant(s)	
	10/693,881	KUBO ET AL.	
	Examiner	Art Unit	
	Vickey Ronesi	1714	

--The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 24 October 2005 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE.

1. ☒ The reply was filed after a final rejection, but prior to or on the same day as filing a Notice of Appeal. To avoid abandonment of this application, applicant must timely file one of the following replies: (1) an amendment, affidavit, or other evidence, which places the application in condition for allowance; (2) a Notice of Appeal (with appeal fee) in compliance with 37 CFR 41.31; or (3) a Request for Continued Examination (RCE) in compliance with 37 CFR 1.114. The reply must be filed within one of the following time periods:

a) ☒ The period for reply expires 3 months from the mailing date of the final rejection.

b) ☐ The period for reply expires on: (1) the mailing date of this Advisory Action, or (2) the date set forth in the final rejection, whichever is later. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of the final rejection.

Examiner Note: If box 1 is checked, check either box (a) or (b). ONLY CHECK BOX (b) WHEN THE FIRST REPLY WAS FILED WITHIN TWO MONTHS OF THE FINAL REJECTION. See MPEP 706.07(f).

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

NOTICE OF APPEAL

2. ☐ The Notice of Appeal was filed on _____. A brief in compliance with 37 CFR 41.37 must be filed within two months of the date of filing the Notice of Appeal (37 CFR 41.37(a)), or any extension thereof (37 CFR 41.37(e)), to avoid dismissal of the appeal. Since a Notice of Appeal has been filed, any reply must be filed within the time period set forth in 37 CFR 41.37(a).

AMENDMENTS

3. ☐ The proposed amendment(s) filed after a final rejection, but prior to the date of filing a brief, will not be entered because

(a) ☐ They raise new issues that would require further consideration and/or search (see NOTE below);

(b) ☐ They raise the issue of new matter (see NOTE below);

(c) ☐ They are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or

(d) ☐ They present additional claims without canceling a corresponding number of finally rejected claims.

NOTE: _____. (See 37 CFR 1.116 and 41.33(a)).

4. ☐ The amendments are not in compliance with 37 CFR 1.121. See attached Notice of Non-Compliant Amendment (PTOL-324).

5. ☒ Applicant's reply has overcome the following rejection(s): claim objection over claim 1.

6. ☐ Newly proposed or amended claim(s) _____ would be allowable if submitted in a separate, timely filed amendment canceling the non-allowable claim(s).

7. ☒ For purposes of appeal, the proposed amendment(s): a) ☒ will not be entered, or b) ☐ will be entered and an explanation of how the new or amended claims would be rejected is provided below or appended.

The status of the claim(s) is (or will be) as follows:

Claim(s) allowed: _____.

Claim(s) objected to: _____.

Claim(s) rejected: 1-5 and 9-13.

Claim(s) withdrawn from consideration: _____.

AFFIDAVIT OR OTHER EVIDENCE

8. ☐ The affidavit or other evidence filed after a final action, but before or on the date of filing a Notice of Appeal will not be entered because applicant failed to provide a showing of good and sufficient reasons why the affidavit or other evidence is necessary and was not earlier presented. See 37 CFR 1.116(e).

9. ☐ The affidavit or other evidence filed after the date of filing a Notice of Appeal, but prior to the date of filing a brief, will not be entered because the affidavit or other evidence failed to overcome all rejections under appeal and/or appellant fails to provide a showing a good and sufficient reasons why it is necessary and was not earlier presented. See 37 CFR 41.33(d)(1).

10. ☐ The affidavit or other evidence is entered. An explanation of the status of the claims after entry is below or attached.

REQUEST FOR RECONSIDERATION/OTHER

11. ☐ The request for reconsideration has been considered but does NOT place the application in condition for allowance because: _____.

12. ☐ Note the attached Information Disclosure Statement(s). (PTO/SB/08 or PTO-1449) Paper No(s). _____

13. ☐ Other: _____.

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Attachment to Advisory Action

First note that in claim 1, line 4, the word “phorphorous” is a misspelling of the word “phosphorus”.

Applicant’s response filed 10/24/2005 has been fully considered but is not persuasive.

Specifically, applicant argues (A) that none of the cited prior art of record discloses or suggests an improvement in properties for a polyester resin produced by condensing raw material monomers in the presence of a tetra-substituted titanium catalyst and an inorganic phosphorus compound as compared with an organic phosphorus compound; (B) that Barkey does not disclose or suggest the use of a catalyst poison such as inorganic and organic phosphorus compounds in combination with titanium catalysts which provides for improved properties; (C) that data provided by applicant established that improved results are obtained in toner resin applications by the presently claimed composition; (D) that Kawase et al does not disclose the presently claimed tetra-substituted titanium compounds; (E) that Harozoe et al does not disclose or suggest the polycondensation of raw material monomers in the presence of a titanium catalyst and phosphorus compound; and (F) that Adams et al only describes a postcondensation catalyst system using a titanium catalyst and phosphorus compound but does not disclose the presently claimed catalyst system for monomer condensation.

With respect to argument (A), it is noted that the features upon which applicant relies (i.e., the alleged improved properties) are not recited in the rejected claim. Case law holds that although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

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With respect to argument (B), Barkey anticipates the instant claims since it specifically discloses the use of six catalysts (one of which is tetraisopropyl titanate) (col. 6, lines 56-58) and four catalyst “poisons” (two of which are inorganic phosphorus compounds) (col. 7, lines 26-29) in an amount of 0.1-0.5 wt % (col. 7, line 35). While a combination of a tetrasubstituted titanium catalyst and an inorganic phosphorus compound is not exemplified, such is clearly envisaged. In particular, 3 out of 24 combinations from the above lists provides for the presently claimed composition. The improved properties are inherently present.

With respect to argument (C), first, applicant’s data are not commensurate in scope with the presently claimed invention. In particular, proper side-by-side examples include Ex. 1, Comp. Ex. 6, and Comp. Ex. 9 wherein an inventive composition comprising titanium diisopropylate bis(triethanolamine) and polyphosphoric acid (Mn = 580) is compared to compositions comprising either dibutyltin oxide and triphenylphosphine. Applicant does not have support for unexpected results for the presently claimed composition comprising generic tetrasubstituted titanium compounds and inorganic phosphorus compound. Case law holds that evidence of superior properties in one species insufficient to establish the nonobviousness of a subgenus containing hundreds of compounds). *In re Greenfield*, 571 F.2d 1185, 1189, 197 USPQ 227, 230 (CCPA 1978). Second, applicant’s comparative data do not serve to distinguish over the prior art since they do not disclose the use of titanium diisopropylate bistriethanolamine or dibutyltin oxide. Case law holds that one must compare the claimed subject matter with the closest prior art to be effective to rebut a prima facie case of obviousness. *In re Burckel*, 592 F.2d 1175, 201 USPQ 67 (CCPA 1979).

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With respect to argument (D), see col. 3, lines 15-16 where titanium tetrabutoxide and tetraisopropoxide are disclosed.


With respect to argument (E), Harozoe et al discloses that the catalyst is also present during the esterifying step (col. 5, lines 27-41) and that the phosphorus stabilizer is present in the esterifying step as well (col. 5, lines 42-46).

With respect to argument (F), note that claim 1 is a product-by-process claim and therefore “even though product-by-process claims are limited by and defined by the process, determination of patentability is based on the product itself. The patentability of a product does not depend on its method of production. If the product in the product-by-process claim is the same as or obvious from a product of the prior art, the claim is unpatentable even though the prior product was made by a different process.” See *In re Thorpe*, 777 F.2d 695, 698, 227 USPQ 964, 966 (Fed. Cir. 1985). Thus, while the composition of Adams et al is prepared by a different process than presently claimed, nevertheless, it discloses the presently claimed composition which results in the presently claimed product, absent evidence to the contrary.

10/31/2005

vr




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